

REMARKS

Upon entry of the present amendment, the pending claims in the present application will not have been amended. However, dependent claims 15-25 will have been submitted for consideration by the Examiner. These newly submitted claims depend from allowable independent claims and more particularly define features of Applicant's claimed invention.

In view of the herein contained remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all of the claims pending in the present application. Such action is respectfully requested and is believed to be appropriate and proper.

Initially, Applicant wishes to respectfully thank the Examiner for conducting a brief telephone interview during which the outstanding rejection was discussed and the Examiner amplified his interpretation of the MORONAGA et al. document.

In the outstanding Official Action, the Examiner rejected claims 1, 3-5, 7-11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over MORONAGA et al. (U.S. Patent No. 5,956,084) and in view of NIWA (U.S. Patent No. 6, 538,692).

Applicant respectfully traverses the above rejection and submits that it is inappropriate with respect to the claims pending in the present application. In particular, Applicant respectfully submits that the combination of features recited in each of Applicant's independent claims 1 and 13 are not taught, disclosed or rendered obvious by any proper combination of MORONAGA et al. and NIWA. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection asserted against the claims pending in the present application.

Neither MORONAGA et al. nor NIWA is directed to a blank photographing operations at all. Rather, MORONAGA et al. is directed to an electronic still-video camera and discloses an internal RAM 28 and an external RAM 31. Based on manipulation of various switches by the operator, image data can be stored in either one of these RAMs. Particularly, MORONAGA et al. does not disclose an electronic-still camera that includes a blank photographing operation performing processor that, in a blank photographing mode, stores image data in the buffer memory without storing the image data in the recording medium. In other words, the image data stored in the internal RAM will be transferred from the internal RAM to an external recording medium.

In discussing the MORONAGA et al. reference, the Examiner admits that the same does not disclose a volatile buffer memory or a normal photographing operation performing processor, as recited in Applicant's claims. Further, the Examiner admits that MORONAGA et al. does not disclose a blank photographing operation performing processor that performs the photographing operation in a blank photographing mode when a recording medium sensing processor senses that the recording medium is not mounted. For these features, the Examiner relies upon NIWA.

In discussing NIWA, the Examiner asserts that a buffer memory is provided therein. The Examiner makes reference to element 44 of Fig. 6 of NIWA which is described at column 10, lines 37-40. However, the Examiner's characterization of the internal memory 44 of NIWA as the volatile buffer memory as recited in Applicant's claim is inaccurate. In this regard, while NIWA does disclose that data in the internal memory is overwritten by sequentially entered new data, this is in the context that coded data is sent from the internal memory to the external recording media on a FIFO basis.

In other words, overwriting in the internal memory occurs after the coded data has been transferred to the external recording media.

Additionally, the Examiner asserts that NIWA discloses a normal photographing operation performing processor in the form of element 40 of Fig. 6. The Examiner asserts that the normal photographing operation performing processor performs a photographing operation in which, after storing image data in the buffer memory, the image data is read from the buffer memory and recorded in recording medium. The Examiner concludes that it would be obvious to incorporate, *inter alia*, these two features of NIWA in the MORONAGA electronic still-video camera.

It is respectfully submitted that the Examiner is incorrect. MORONAGA et al. does not disclose a device where data is first stored in the internal memory and then transferred from the internal memory to the external memory. The Examiner asserts that NIWA teaches modifying MORONAGA et al. to include this feature. However, to do so would be inefficient and thus unobvious. The Examiner has asserted no logical reason to first store data in an internal RAM and then move it from the internal RAM to the external RAM. To so modify MORONAGA would be to complicate the operation thereof and is thus submitted to be lacking in motivation.

Independently of the above, it is respectfully submitted that the Examiner has provided no proper motivation for the proposed modification of MORONAGA et al. with the teachings of NIWA. The Examiner merely concludes that it would be obvious for one of ordinary skill in the art to modify MORONAGA et al. in view of NIWA, to include the features that are not disclosed in and are lacking from MORONAGA. In setting forth the rejection, the Examiner asserts that NIWA provides the advantage of automating

switching between photographing modes. However, in doing so, the operator lose significant freedom and flexibility, which is a prime purpose of the MORONAGA et al. disclosure. Thus, it is submitted that there is no motivation to utilize the features of NIWA in the electronic still-video camera of MORONAGA.

According to the teachings of NIWA, whenever there is space in the external recording medium, image data is recorded therein. It is only when there is inadequate space (or when the external recording medium is removed) that the internal recording medium is utilized, which is directly contrary to the teachings of MORONAGA et al. Additionally, in NIWA, when the external recording medium is again installed, the data is sent from the internal memory to the external recording medium (column 10, lines 27-29). Accordingly, there is no blank photographing mode as recited in Applicant's claims.

Accordingly, for each of the above-noted reasons and certainly for all of the above-noted reasons it is respectfully that the combination of features recited in Applicant's claims are not taught by either of MORONAGA or NIWA or by any proper combination thereof. Additionally, the proposed combination asserted by the Examiner is lacking in the proper motivation required under 35 U.S.C. § 103.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection together with an indication of the allowability of all of the claims pending in the present application.

By the present response, Applicant has submitted several additional claims for consideration by the Examiner. These claims define additional features of Applicant's invention with specificity and clarity and enhance the distinctions between the present invention and the references relied upon by the Examiner. Accordingly, these claims

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provide yet additional bases for the patentability of the present invention. The Examiner is respectfully requested to consider the newly submitted claims together with the pending claims and indicate the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has not amended the pending claims but has submitted several additional dependent claims for consideration to more specifically define the features of the present invention and emphasize the distinctions between Applicant's invention and the references relied upon.


Applicant has discussed the disclosures of the references relied upon and has pointed out the shortcomings thereof with respect to the present invention. Applicant has discussed the explicitly recited features of Applicant's invention and has pointed out the deficiencies of the references cited by the Examiner as well as deficiencies of the combination of references cited by the Examiner. Applicant has further pointed out the lack of proper motivation for the proposed combination of references cited by the Examiner.

Accordingly, Applicant has provided a clear evidentiary basis for the patentability of all the claims in the present application and respectfully requests an indication to such a fact in due course.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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